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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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SNELL & WILMER ONE ARIZONA CENTER 400 EAST VAN BUREN PHOENIX, AZ 85004-2202			WALSH, DANIEL I	
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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/710,307	Applicant(s) BONALLE ET AL.	
	Examiner Daniel I. Walsh	Art Unit 2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 4-19-06 (pre amendment).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Receipt is acknowledged of the pre-amendment received on 19 April 2006.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 21 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for different accounts, does not reasonably provide enablement for the first and second user accounts being associated with different users. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. Claim 21 recites first and second user accounts are from different users. However, the specification teaches that the sample is of one user (paragraph [0245]), which teaches the accounts are from the same user.

Appropriate correction is required.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. Claims 1-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Re claim 1, the claim recites the biometric sample is associated with a preset transaction limitation independent of any limitation associated with said account. The Examiner notes that this is vague/indefinite, because the Examiner believes that the transaction limitation associated with the biometric is related, albeit different, to an account limitation. For example, a transaction limitation of the biometric cannot exceed a transaction limitation of the card (credit limit), so it is unclear on how the transaction limitation of the biometric is independent from the account limitations, if the biometric must conform and not exceed the maximum credit line available, for example. The Examiner has interpreted the limitations as the biometric is not merely associated by extension to a transaction limitation of the card (credit limit of the card) but provides a level of security (required for certain purchases).

Re claim 19, the claim recites sending a signal when an established rule is being violated. It is unclear how an established rule can be violated; the point of rules/limitations is to prevent thing from occurring that are outside certain guidelines/rules. If the "rules" are violated, it is unclear how they can be established rules in the first place.

Re claim 21, it is unclear how a first biometric sample is primary associated with a first account and a second sample is secondarily associated with a second account, if the users are different. If the users are different, the associations would be independent, and therefore it is unclear how different samples would be primarily and secondarily associated if the users are different. They would appear to be just associated, not primarily and secondarily, since the users are unique. The Examiner for purposes of Examination has interpreted this as two users with different respective accounts, as is conventional.

Appropriate clarification/correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-13, 15, 17-19, and 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Black (US 2005/0122209) in view of Baer (US 2005/0232471).

Re claim 1, Black (US 2005/0122209) teaches a smartcard transaction system configured with a biometric security device, the system comprising: a smartcard configured to communicate with a reader, wherein the reader and biometric security device communicate with a host; a biometric security device comprising a biometric sensor configured to detect a proffered biometric sample, the biometric sample configured to communicate with the system; and, a means to verify the proffered biometric sample to facilitate a transaction (FIG. 1C, which teaches

a smartcard (abstract), smartcard reader, biometric sensor (step 6 of FIG. 1C), and steps 7+ which teach authentication and to facilitate a transaction (by a device)). Though Black is silent to a specific verification device, the Examiner notes that it would have been obvious to one of ordinary skill in the art to use a verification device to verify that the sample is an authentic biometric sample, for increased security. The Examiner notes that such devices are conventional in the art and therefore are obvious expedients. Black teaches the associate with one of the claimed accounts, as taught above.

Black is silent to the biometric sample being associated with a preset transaction limitation independent of any limitation associated with the account.

Baer teaches such limitations (paragraph [0037]).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Black with those of Baer.

One would have been motivated to do this to provide different levels of security based on biometrics. Increased security based on the probability of authentication is well known and conventional in the art as well, where PIN and secondary security procedures are used to authorize transactions of certain type/amounts, as well.

Re claim 2, Black teaches the sensor is configured to communicate with the system via at least one of a smartcard, a reader, and a network (FIG. 1C).

Re claim 3, Black teaches the biometric sample is captured (see above). Though silent to a sensor facilitating a finite number of scans, it is obvious that a finite number of scans is facilitated (one for example) to receive the biometric.

Re claim 4, Black teaches that the digital and electronic signatures are captured and preserved in a transaction record (paragraph [0125]). This is interpreted to include logging at least one of a detected biometric sample, processed biometric sample, and stored biometric sample. Though Black is silent to the biometric sensor doing the logging, the Examiner notes that it would have been obvious for the sensor to do the logging, since it captures/receives the inputs. Additionally, though silent to security procedures when the data doesn't match, the Examiner notes that it is well known and conventional to allow users a couple attempts to access a system before performing a security procedure (3 attempts at a password, PIN, etc. before blocking access for a predetermined time). It would have been obvious to allow the user a couple attempts before blocking the user, transponder, etc. to provide the user an attempt to rectify a mistake made during providing biometric information. Such means are well known and conventional in the art for access control, and employing them in a biometric system is an obvious expedient to provide security, while also allowing a user more than one attempt at access in case a mistake is made.

Re claim 5, Black teaches that a data packet is stored remotely (host computer) where the data packet includes at least one of proffered and registered biometric samples proffered and registered user information, terrorist information, and criminal information (paragraph [0125], FIG. 10A-11B and 14A-14B). The Examiner notes that though such data packet/information is shown with reference to a transponder/RFID, Black states that the device can be a smartcard, transponder, etc. (abstract). Accordingly, it is obvious that such teachings can be applied to smartcards to produce expected results for data storage and retrieval for verifying a transaction using biometrics, especially since it has been taught that such information can be stored on the

transponder/card itself or remotely (for security reasons) (paragraph [0090] +). Though silent to a database, the Examiner notes that storing records on a computer in a database is an obvious expedient, well within the skill in the art to organize data for efficient comparison and retrieval.

Re claim 6, as discussed above, the data packet information can be stored on a host computer, which is interpreted to include at least one of the smart card, smartcard reader, sensor, remote server, merchant server, and smartcard system. Though not specifically identified as a server, it would be obvious that the computer is a server, in order to process data/access remotely, for example.

Re claim 7, Black teaches the host computer is associated with the registering and storing/processing of the biometric data used to verify transactions. Though silent to an authorized sample receiver, it is obvious that such a receiver would be authorized, as it is used to facilitate and verify biometrics for transactions.

Re claim 8, Black teaches a device configured to compare a proffered biometric sample with a stored biometric sample (FIG. 1C).

Re claim 9, Black teaches a device configured to compare at least one characteristic of a biometric sample including at least one of minutia, vascular patterns, prints, waveforms, odorants, nodal points, reference points, size, shape, thermal patterns, blood flow, and body heat (FIG. 1C which teaches comparison of fingerprint and signature).

Re claim 10, Black teaches (FIG. 1A) that the host computer can store the reference data. The Examiner notes it would have been obvious for the samples to be stores in a third-party biometric security vendor or government agency as a means to provide secure storage. As the system of Black can be used for point of sale transactions, for example, it would have been

obvious that the host computer would be remote from the transaction. Such secure storing of the samples would have been an obvious expedient to protect data and provide security. It is understood that a third party security vendor or government agency can provide such security, and therefore is an obvious expedient for the data storage.

Re claim 11, Black teaches the comparison of sensed data with reference data (FIG. 1C). The reference data is a registered biometric sample.

Re claim 12, Black teaches a registered biometric sample is associated with at least one of personal information, credit card information, debit card information, savings account information, membership information, PayPal account information, Western Union account information, electronic bill payment information, automatic bill payment information and loyalty point information (abstract, as an account is linked with the biometrics provided during a registration).

Re claim 13, as Black teaches different people using the system with different biometrics, it is obvious that each sample would be associated with a different account, because different peoples samples would be unique, and each person could have a sample linked to an account.

Re claim 15, as Black teaches that an account is only accessed after a sample is verified, it is interpreted as beginning authentication after the sample is verified.

Re claim 17, though Black is silent to the sensor providing notification upon detection of a sample, the Examiner notes that it is well within the skill in the art to provide notification that a sample has been detected/received (see previous Office Actions reference to Janiak et al.).

Though Black is silent to providing notification that a primary account is being accessed, the Examiner notes that the failure to detect a sample/fail to verify a sample, would be evident to the

user by a lack of response or a rejected attempt. Positive notification is merely an equivalent.

Further, the Applicant has not shown that positive notification of sample detecting would materially affect the workings of the invention, as compared with what can be considered passive notification. The Examiner notes that merely providing notification that the account is being accessed (to the customer/store employee for example) is well known and conventional in the art as evidenced through conventional debit/credit card transactions which indicate to users/workers that authorization is occurring, and through processing and completion of the transaction, positive notification is provided (such as through text, audio, visual, or mere completion of the transaction). It would have been obvious to one of ordinary skill in the art to provide such information, in order to keep the customer/worker aware of the status of the transaction.

Re claim 18, Black teaches the device configured to verify is further configured to facilitate at least one of access, activation of a device, a financial transaction, and a non-financial transaction (abstract, and as the system as a whole facilitates such means, and as a verification device is part of the system is therefore facilitates such means).

Re claim 19, as it has been discussed above re Baer that transactions above a certain amount require a certain biometric, the Examiner has interpreted such teachings as overriding a rule as claimed. As such, as the transactions are conventionally logged, it would have been obvious to report all transactions, including those over a certain amount (requiring a biometric) to the host for record keeping.

Re claim 20, as discussed above, the preset transaction limitation comprises at least one of a maximum transaction amount, minimum amount, etc. as claimed.

Re claim 21, the Examiner notes that different users would obviously have different/unique accounts in order to separate their assets/accounts securely, as is conventional in the art for providing unique accounts for different users.

5. Claim 14 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Black/Baer, as discussed above, in view of de Sylva.

Re claim 14 the teachings of Black/Baer have been discussed above.

Black/Baer is silent to the sample being primarily associated with a first user account and secondarily associated with another account, different from the first.

De Sylva teaches such limitations through the use account record 30.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Black/Baer with those of de Sylva.

One would have been motivated to do this to have additional accounts associate with a sample for more flexibility and customization for the user.

Re claim 19, Black teaches the device configured to verify is configured to facilitate the use of at least one secondary security procedure (signature, metrics FIG. 1C). Black teaches the use of a transaction record (paragraph [0125]) but it silent to the record occurring during unauthorized access attempts. However, the Examiner notes it would have been obvious to one or ordinary skill in the art to store such attempts in order to obtain security information regarding usage and attempts to access accounts illegally. Additionally, the Examiner notes that it is understood that if access is blocked due to improper authentication, the host would be area of this because the host is the entity through which authentication occurs, and storing such

information would have been obvious for security reasons (detecting fraud attempts, system breaches, etc).

Black is silent to the verification device sending a signal to the host device to notify that an established rules for the transponder is being violated.

De Sylva teaches remote database 32 stores non-authenticated data from the verifier (50) (paragraph [0032]).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Black/Baer with those of de Sylva.

One would have been motivated to do this in order to alert instances of fraud. It would have been obvious for the verification device to complete such steps, as it is responsible for verifying the sample, if the sample is not verified it would be obvious to create notification for fraud.

6. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Black/Baer, as discussed above, in view of Moebs et al. (US 2005/0065872).

Re claim 14 the teachings of Black/Baer have been discussed above.

Black/Baer is silent to the sample being primarily associated with a first user account and secondarily associated with another account, different from the first.

Moebs et al. teaches such limitations (paragraph [0017]).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Black/Baer with those of Moebs et al.

One would have been motivated to do this to have overdraft protection.

7. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Black/Baer, as discussed above, in view of Goodman, as cited in the previous Office Action.

Re claim 16, the teachings of Black/Baer have been discussed above.

Though it is obvious that if the biometric samples do not match that a transaction is not permitted to be executed, Black/Baer is silent to the smartcard deactivating upon rejection of the biometric sample.

Goodman et al. teaches Goodman et al. teaches deactivation of a card if a predetermined amount of incorrect PIN attempts are detected (paragraph [0029]).

At the time the invention was made, it would have been obvious to an artisan of ordinary skill in the art to combine the teachings of Black/Baer with Goodman et al.

One would have been motivated to do this to increase the security of the system by disabling a card after a number of incorrect inputs.

Though Goodman is silent to a biometric input, the Examiner notes that Goodman supplies a teaching for disabling a card when a matching input is not received. As Black teaches not allowing a transaction, when a input is not matched (and other reference cited in the previous Office Action teach contacting authorities), it would have been obvious to use the teachings of Goodman to expand the security measures and to disable the card so that unauthorized used does not occur, when biometric inputs do not match, where biometric inputs are interpreted as an alternative security measure to PIN inputs, to provide additional security. Biometric samples are a more secure identifier (as taught by Black) but it would still be obvious to disable the card when the identifiers do not match, whether it be a PIN or biometric, in order to increase security/reduce fraud.

Additional Remarks

8. The Examiner notes that different levels of security are well known and conventional in the art. For example, Deo et al. (US 5,721,781) teaches based on transaction amounts, different information is required in order to provide security/assurance that the user is valid (see Fig. 9), Rasmussen et al. (US 6,834,795) teaches similar teachings (FIG. 5), and Tetro et al. (US 6,095,413) teaches added security through use of a separate databases).

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Deo et al. (US 5,721,781), Rasmussen et al. (US 6,834,795), and Tetro et al. (US 6,095,413).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel I. Walsh whose telephone number is (571) 272-2409. The examiner can normally be reached on M-F 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel I Walsh

Examiner

Art Unit 2876

4-25-06

A handwritten signature in black ink, appearing to be 'D. Walsh', written over the printed name and date.